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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/429,723	10/29/1999	CLAUDE HOPE	BAL6019P0011	6250

7590 01/26/2004

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EXAMINER

GRUNBERG, ANNE MARIE

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 01/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding:

Office Action Summary

Application No.

09/429,723

Applicant(s)

HOPE ET AL.

Examiner

Anne Marie Grunberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The Request for Continued Examination (RCE) filed on 10/20/03 under 37 CFR 1.114 based on parent Application No. 09/429,723 is acceptable and an RCE has been established. An action on the RCE follows.

Claims 41-76 are pending.

Applicant is advised that should claim 41 be found allowable, claim 59 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Applicant is further advised that dependent claims 60-76 are affected as well.

Applicant has indicated that the deposit requirements will be met upon indication of allowable subject matter. However, it is noted that the *Eustoma* cultivars taught in the specification are hybrids or are still segregating. In order to meet the deposit requirement for hybrid cultivars, seed that produce the hybrids may be deposited if they are homozygous for all traits. As a result Applicant may choose to deposit both homozygous parental lines that when crossed produce the particular hybrid lines. In this case it would be necessary to declare that the parents are homozygous for all traits such that they will breed true to the parent if planted.

However, it should be noted that seed of segregating cultivars may not be deposited in order to meet the deposit requirements of a segregating line. A segregating line is unstable and seed therefrom will not reproduce true to type. As a result, a segregating line may not be able to meet deposit requirements. In this case, the only viable solution may be to deposit tissue of such plants.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. New claims 41-42, 55, 57-60, 73, 75-76 and dependent claims 43-54, 56, 61-72, 74 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for reasons indicated in the previous office action.

i. New claims 41-42, 55, 57-60, 73, 75-76 and dependent claims 43-54, 56, 61-72, and 74 are rejected for the same reasons claims 19, 26, 32, 33, 36-37, and 39-40 and dependent claims 20-25, 27-31, 34, and 35 were rejected in the last action. It is not clear what "reduced apical dominance" is, nor is it sufficiently defined in the specification. The recessive allele has not been sufficiently characterized either. As a result, it is unclear when a plant contains a recessive allele for reduced apical dominance – especially when it exists in the heterozygous state.

ii. Claim 48 is newly rejected due to the recitation of "inbred". An inbred plant is one that is homozygous for all its alleles. At page 5, lines 14-16 of the specification it states that the "inbred" was discovered within a segregating F₂ generation. However, the plants within an F₂ are still segregating and can not be inbred. As a result, it is unclear what is meant by "inbred".

Written Description

3. Claims 41-76 are rejected under 35 U.S.C. 112, first paragraph for the same reasons that claims 19-35 were rejected in the previous action for written description purposes.

The Eustoma seed deposited by Applicant is seed that will form a heterozygous population when grown. The seed is not from an inbred plant that breeds true to type. Conversely, the seed will produce plants that have not been fully characterized nor can they be fully characterized until they are grown. This rejection may be overcome if tissue culture with regenerable cells capable of expressing the parent plant are deposited instead. Claims drawn to future generations of such a plant would not be able to overcome the rejection because it is not possible to characterize future generations.

Claim Rejections - 35 USC § 102

4. Claims 41-76 are rejected under 35 U.S.C. 102(b) as being unpatentable over Harbaugh et al for the same reasons expressed in the previous office action for claims 19-25, 32, and 35-36.

The claims are drawn to Eustoma plants or seeds that are indistinguishable from the plants taught by Harbaugh et al. Parts of the plant and methods of breeding the plant as well as future generations derived therefrom are taught by Harbaugh et al as discussed in the previous action.

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any


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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne Marie Grünberg whose telephone number is (571) 272-0975. The examiner can normally be reached Monday through Friday from 8:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell, can be reached on (571) 272-0974. The fax phone number for this group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.


ANNE MARIE GRUNBERG
PATENT EXAMINER